

1. The Benefit of Continuity.

The Examiner indicated in the Official Action that the benefit of priority would not extend back to the original parent application 06/698032 filed September 6, 1984 or any of the other subsequent parent applications. The Examiner stated that the present formal drawings show a change to the flashlight disclosed in the parent applications.

The original drawings submitted on September 6, 1984 comprised two sheets and eight figures. As part of the Official Action of November 13, 1990, the Examiner included a copy of these original drawings which included a Note A directed to Figures 1 and 8. These original drawings are attached hereto as Exhibit A. For purposes of identification these original drawings which comprise Exhibit A will be referred to as the "06/648032 drawings."

It is the Examiner's position that the change shown in the present formal drawings over the flashlight disclosed in the parent applications relates to a rounded head in Figures 1 and 2 of the present formal drawings. This rounded head serves as the base for the flashlight in the candle mode. The Examiner has stated that the candle mode flashlight shown in Figure 8 of the 06/648032 drawings is "a direct embodiment of Fig. 1" of those drawings and that "[T]he Fig. 1 head shows a distinct contour that marks a definite change in plane." Applicant respectfully disagrees with the Examiner's position.

First it should be noted that the head in Figure 8 of the 06/648032 drawings, to the extent it is shown, does not show

a contour that marks a definite change in plane. Furthermore, the profile of the head shown in Figures 2 and 3 of the 06/648032 drawings, as well as in the drawings of the other parent applications, show a rounded head. Note B on Figures 2 and 3 in the drawings attached as Exhibit A. To the extent that any difference exists between the rounded head of Figures 1 and 2 of the present formal drawings and the rounded head shown in Figures 2 and 3 of the drawings of the parent applications, it is inconsequential because there is a reasonable degree of precision between the present formal drawings and the drawings of the parent applications. In this regard, we direct the Examiner's attention to Ex parte Asano, 201 USPQ 315 (Bd. App. 1978) which states at page 317:

While we agree with the general premise, as stated by the examiner that, in design applications, the drawing or drawings constitute substantially the entire disclosure of the application and must therefore be well executed both in clarity of showing a completeness to provide an enabling disclosure and definiteness of the claimed subject matter (see 1503.02 MPEP), neither the statute (35 USC 112) nor the regulation (37 CFR 1.152) requires blueprint type drawings of an exact scale.

Mechanical drawing errors and inconsistencies between the figures of the drawing, which do not preclude the overall understanding of the

drawing as a whole are an insufficient basis for holding the design both indefinite and insufficiently disclosed under 35 USC 112. Hadco Products, Inc. v. Lighting Corp. of America, Inc., *supra*. As in the cited Hadco Products, Inc., *supra*, we consider the numerous mechanical drawing errors and figure inconsistencies noted by the examiner to be insignificant, and that they would present no problems as far as making the disclosed design to one of ordinary skill in the art. As set forth in *In re Wiggins et al*, 488 F.2d 538, 179 USPQ 421, 424 (CCPA 1973):

"* * * Every patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that disclosed in order that it be 'enabling' with the meaning of § 112 * * *."

With regard to the rejection under the second paragraph of 35 USC 112, the inquiry is whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. *In re Moore et al*, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (1971). Since the words in the appealed claim herein refers to the showing in the drawings, the same issue surrounding the enablement issue discussed above are

generally the same as the definiteness issues under the second paragraph of 35 USC 112. It is our opinion as set forth above, that the original drawings are sufficiently precise here to reasonably appraise one skilled in the art what the metes and bounds of the invention are and we do not therefore consider the claim indefinite. Compare *In re Miller*, 58 CCPA 1182, 441 F.2d 689, 169 USPQ 597 (1971).

In view of the above, it is submitted that adequate conformity exists between the present formal drawings and the 06/648032 drawings as well as the drawings of the other parent applications and, thus, the present application is entitled to the benefit of continuity extending back to the original parent application Serial No. 648,032 filed September 6, 1984.

However, because modification of the present formal drawings may expedite prosecution of this application, Applicant is willing to submit such modified drawings to the Examiner and will do so as soon as they are completed.

2. Figure Descriptions

On page 2 of the Official Action the Examiner indicated that the figure descriptions should be amended. As indicated above, the figure descriptions have been amended. The present figure descriptions for Figures 2 through 4 are the same as listed by the Examiner in the Official Action. The figure description for Figure 1 is the same as listed by the Examiner in

the Official Action except the flashlight is referred to as a "flashlight in candle mode" which conforms with the title of the invention as set forth in title block of the Preliminary Amendment.

3. Claim Modification

The Examiner has required a modification of the claim because of the added description regarding the other opposite side of the flashlight shown in Figure 2 of the drawings. The claim has been amended to reflect this modification. The Examiner also objected to the form of the claim and it has been amended as suggested by the Examiner except, instead of the term "MINIATURE FLASHLIGHT" proposed by the Examiner, the term "candle mode flashlight" is used in order to conform with the name of the invention.

4. Drawing Corrections

In paragraph 5 on page 3 of the Official Action, the Examiner listed certain objections to the September 22, 1989 drawings. The drawings will be corrected in order to overcome each of the objections set forth by the Examiner. However, the new drawings are now being prepared and the Examiner indicated in paragraph 7, page 3 of the Official Action that correction of these defects can be deferred until the application is allowed by the Examiner.

5. The Claim Rejection

The Examiner rejected the claim under 35 U.S.C. 103 as being unpatentable over Maglica, U.S. Patent No. 4,658,336, Fig. 8, in view of Huang, U.S. Patent No. 4,750,095. For the

reasons previously set forth above, it is submitted that continuity has been established between the present design application and the original patent application, Serial No. 648,032. Because of this continuity neither Maglica, U.S. Patent No. 4,658,336 nor Huang, U.S. Patent No. 4,750,095, constitute prior art and the rejection of the claim under 35 U.S.C. 103 is overcome.

In view of the above, it is respectfully submitted that the application is now in condition for allowance. The Examiner is respectfully requested to promptly pass this application to issue, particularly since a petition to make this case special on the basis of infringement been granted.

Respectfully submitted,

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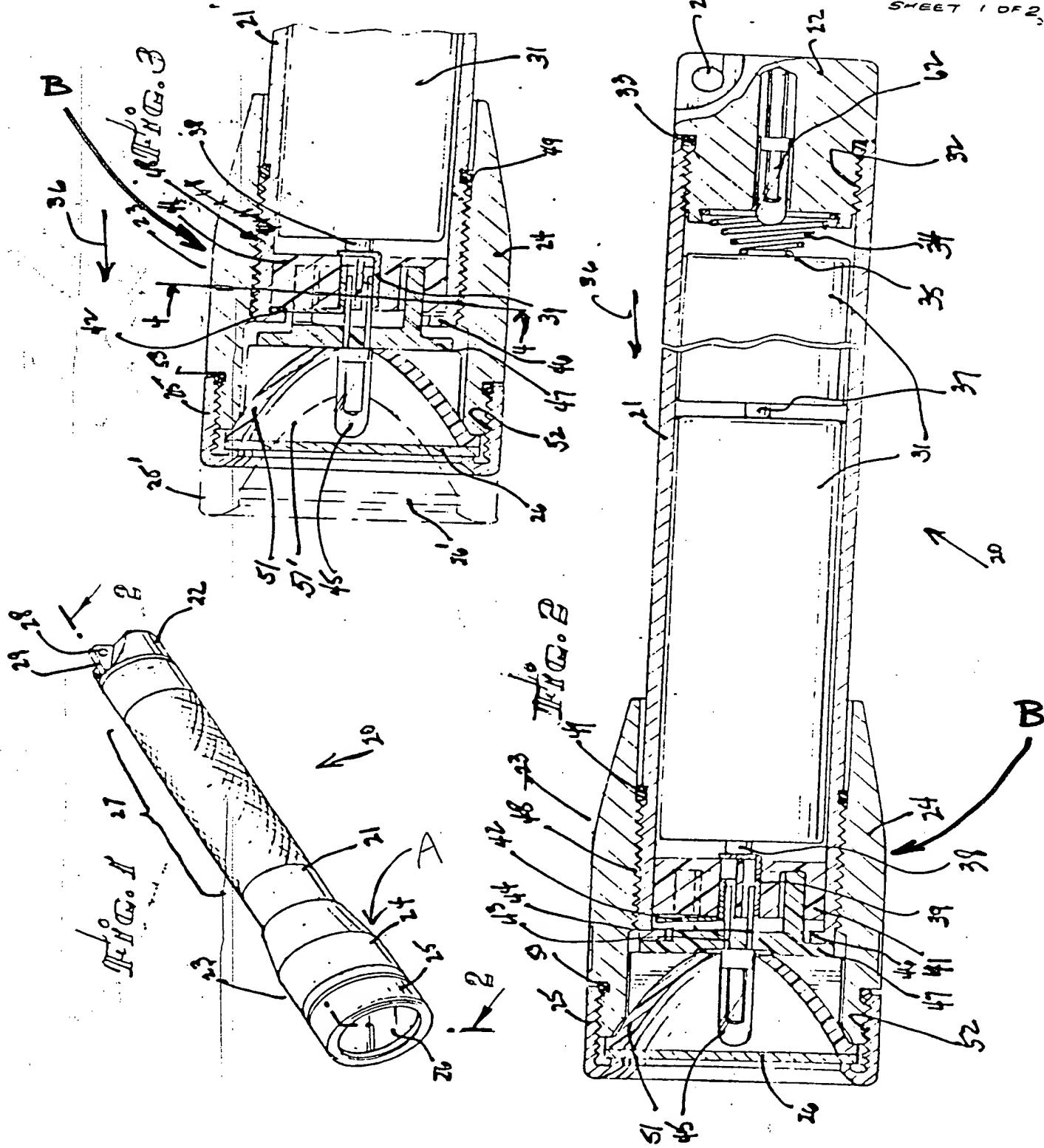
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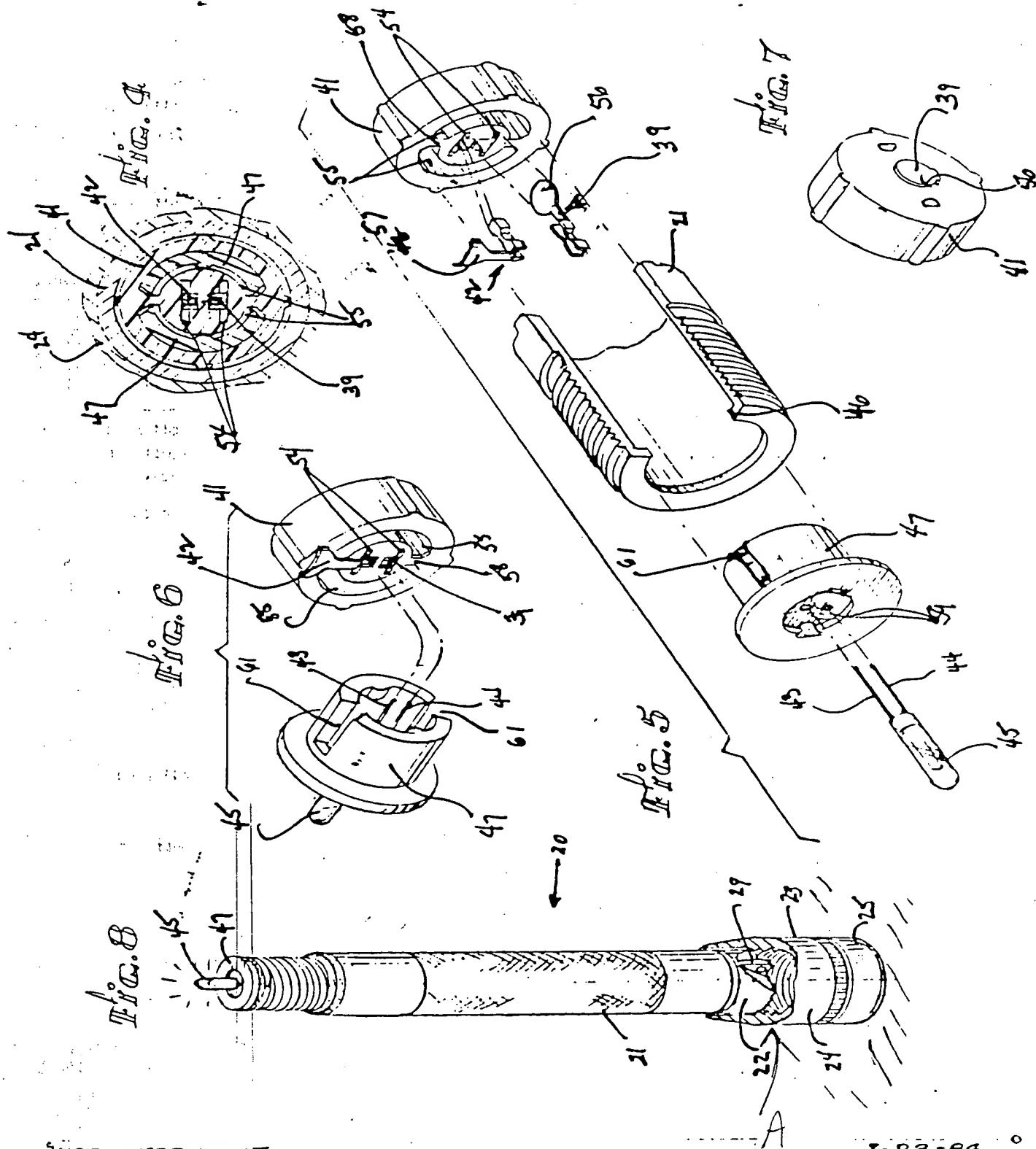
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